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NGUYEN *et al.*  
Appln. No. 09/227,881**Remarks****I. Objection of Claim 131 Under 37 C.F.R. § 1.75(c)**

Applicants submit that the cancellation of claim 131 renders the objection moot and respectfully request withdrawal of the rejection.

**II. Rejection of Claims 136 and 137 Under 35 U.S.C. §112 Second Paragraph**

Applicants submit that the cancellation of claims 136 and 137 renders the rejection moot and respectfully request withdrawal of the rejection.

**III. Rejections Under 112 First Paragraph**

**The Rejection of Claims 79-81, 91, 94, 96, 97, 100, 102, 103, 106, 108, 109, 112, 114, 118, 120, 121, 124, 126-132, 134-138 140-143 Under 35 U.S.C. § 112 First Paragraph**

Claims 79-81, 91, 94, 96, 97, 100, 102, 103, 106, 108, 109, 112, 114, 118, 120, 121, 124, 126-132, 134-138 140-143 stand rejected under 35 U.S.C. § 112 ¶ 1 for allegedly failing to comply with the written description requirement. Applicants respectfully disagree with the Examiner's position, however, in order to advance prosecution they have cancelled the claims and present new claims incorporating the helpful suggestions of the Examiner. In view of the amendment, Applicants submit that the rejection is moot and respectfully request withdrawal of the rejection.

**IV. Rejection of Claims 79-81 94 96, 100, 102, 103, 108, 109, 112, 114, 115, 120, 121, 126, 127-132, 134, 135, 137, 138, 139, 140, 141, and 143 Under 35 U.S.C. § 102(b) as Being Anticipated by Becker *et al.***

The Examiner alleges the Becker *et al* "teaches a nucleic acid in vectors and cells that comprise a glucocorticoid response element, which is a fragment of SEQ ID NO: 3" and that

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the fragment Becker teaches "is between 15 and 250 nucleotides long...." Office Action dated June 3, 2004 at page 8.

Applicants respectfully disagree. Anticipation under § 102 can only be found if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780 (Fed. Cir. 1985). Furthermore, anticipation requires that every limitation of the claims be found, either expressly or inherently, in a single prior art reference, device, or practice. *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000); *Gechter v. Davidson*, 116 F.3d 1454, 1458 (Fed. Cir. 1997). That is, the reference must sufficiently describe the claimed invention so as to place it into the possession of the worker of ordinary skill in the art. *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Whatever else Becker *et al* teaches, it does not teach a fragment from about 15 to about 250 nucleotides long of SEQ ID NO: 34 or a fragment from about 15 to about 250 nucleotides long of nucleotides 1 through 5271 of SEQ ID NO: 3. In view of the foregoing, Applicants respectfully request the Examiner to withdraw the rejection. If the Examiner maintains the rejection, Applicants respectfully request the Examiner to identify the precise sequence disclosed by the Becker reference, including its position and nucleotide sequence, and the corresponding nucleotide positions in SEQ ID NO: 3 or SEQ ID NO: 34 relied on to support the rejection.

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Appln. No. 09/227,881**V. Statutory and Non-Statutory Double Patenting****A. Statutory Double Patenting**

**Claim 127 is rejected under 35 U.S.C. § 101 as Claiming the Same Invention as that of Claims 1-6 of U.S. Patent No. 5, 861,497**

The Examiner has rejected claim 127 under 35 U.S.C. § 101 for claiming the same invention as claims 1-6 of US patent 5,861,497. While Applicants respectfully disagree, Applicants have cancelled claim 127 rendering the rejection moot.

**B. Non-Statutory Double Patenting**

**Claims 103, 106, 108, 109, 112, 114, 115, 118, 120, 121, 124, 126, 132-135, and 138-143 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1,2,4,5,7,8,10,1,13, and 15 of US patent 5,606,043.**

**Claims 103, 106, 108, 109, 112, 114, 115, 118, 120, 121, 124, 126, 132-135, and 138-143 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 5, 6, 8, 9, 10, 13, and 14 of US patent 6,150,161.**

**Claims 79, 94, 96, 100, 102, 103, 106, 108, 109, 112, 114, 115, 118, 120, 121, 124, 126, 128, 129, 132, 133, 135, 136, 138, 139, and 141 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-6 of US patent 5,861,497.**

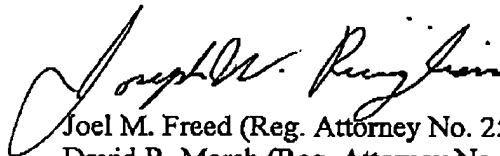
Claims 79, 94, 96, 100, 102, 103, 106, 108, 109, 112, 114, 115, 118, 120, 121, 124, 126, 128, 129, 132-136, and 138-143 stand rejected under the judicially created doctrine of obviousness type double patenting. While Applicants respectfully disagree, Applicants respectfully submit that the cancellation of the previously pending claims and their replacement with claims 144-174 renders the rejection moot.

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Appln. No. 09/227,881**Conclusion**

Applicants submit that the claims are in condition for allowance and solicit a notice of allowability at the earliest possible time. Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicants' undersigned representative at 202-942-5174.

Respectfully Submitted,



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